

Appl. No.: 09/742,719
Amtd. dated 08/04/2005
Reply to Office action of April 27, 2005

REMARKS/ARGUMENTS

In light of the amendments to the claims presented herein and the following remarks, reexamination and reconsideration of this application, withdrawal of the rejections, and formal notification of the allowability of all claims as presented are earnestly solicited. As detailed in the Office Action mailed April 27, 2005, Claims 1-36 are pending, wherein Claims 1-36 have been rejected. In response to the Office Action, Claims 1 and 13-36 have been amended. The amendments to the claims find support throughout the Specification and the Drawings and no new matter has been added. Accordingly, it is believed that the claims now define patentable subject matter over the prior art cited in the Office Action and notice to such effect is requested at the Examiner's earliest convenience.

Specification

The Abstract was objected to in the Office Action for being too lengthy. In response, the Applicant has amended the Abstract to be within the applicable limit. Accordingly, the Applicant requests withdrawal of this objection.

Claim Rejections – 35 U.S.C. §112

Claims 1-36 were rejected in the Office Action as being indefinite for various reasons.

Claim 1 was rejected in the Office Action for insufficient antecedent for the limitation "the tasks" in line 6. The Applicant traverses this rejection. More particularly, the first element of Claim 1 recites a method step of "identifying a plurality of projects comprising the complex process, each project having a start date and a cycle time and further comprising at least one task." The Applicant thus submits that if Claim 1 particularly recites a plurality of projects, where each project includes at least one task, then the claim encompasses a plurality of tasks. Thus, there is sufficient antecedent basis for the term "the tasks" in the second element of Claim 1. Accordingly, the Applicant requests withdrawal of this rejection.

Claim 13 was rejected in the Office Action with respect to the terms "system" and "portion." In response, Claim 13, as well as Claims 14-24 which depend therefrom, have been

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amended to change the term "system" to "computer device," and the term "portion" to "device," to clarify that an apparatus (computer device) is being claimed, wherein such an apparatus includes one or more processing devices particularly configured as stated in the claim. Accordingly, the Applicant submits that this rejection is now moot and requests withdrawal of the same.

Claims 13 and 25 were also rejected in the Office Action for insufficient antecedent for the limitation "the tasks" in lines 8 and 9, respectively. The Applicant traverses these rejections. As previously discussed in relation to the indefiniteness rejection of Claim 1, the first element of each of Claims 13 and 25 particularly recite the limitation "identifying a plurality of projects comprising the complex process, each project having a start date and a cycle time and further comprising at least one task." The Applicant thus submits that if Claims 13 and 25 each particularly recites a plurality of projects, where each project includes at least one task, then each of those claims encompasses a plurality of tasks. Thus, there is sufficient antecedent basis for the term "the tasks" in the second element of each of Claims 13 and 25. Accordingly, the Applicant requests withdrawal of these rejections.

Claims 25-36 were rejected in the Office Action with respect to the term "computer software program product." In response, the Applicant has amended Claims 25-36 to change the term "computer software program product" to "computer-readable medium encoded with a computer program" as suggested in the Office Action. Accordingly, the Applicant requests withdrawal of this rejection.

Claim Rejections – 35 U.S.C. §101

Claims 1-36 were rejected in the Office Action as being directed to non-statutory subject matter under 35 U.S.C. §101, for various reasons. In response, the Applicant addresses each rejection below in turn.

More particularly, Claims 13-24 were rejected under 35 U.S.C. §101 because it was unclear whether those claims were limited to one statutory class. In response, the Applicant has amended Claim 13 to recite that the claimed subject matter is unambiguously directed to a computer device having at least one processing device. Claims 14-24 have also been amended to

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be consistent with the amendment to Claim 13. Accordingly, the Applicant submits that Claims 13-24 are now clearly directed to an "apparatus," comprising statutory subject matter under 35 U.S.C. §101, and that the rejection of Claims 13-24 under 35 U.S.C. §101 have thus been overcome.

Further, Claims 25-36 were rejected under 35 U.S.C. §101 because it was not clear whether those claims were directed to a computer program stored in a computer readable medium. In response, the Applicant has amended Claim 25 to recite that the claimed subject matter is unambiguously directed to a computer-readable medium encoded with a computer program capable of being executed within a computer device. Claims 26-36 have also been amended to be consistent with the amendment to Claim 25. Accordingly, the Applicant submits that Claims 25-36 now clearly comprise statutory subject matter under 35 U.S.C. §101 (MPEP §2106(IV)(B)(2)(a)), and that the rejection of Claims 25-36 under 35 U.S.C. §101 have thus been overcome.

Claims 1-12 were also rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Specifically, even though the Office Action admits that these claims do produce useful, concrete and tangible results, the Office Action alleges that these claims could be performed manually or entirely by hand and do not apply, involve, use, or advance the technological arts. The Applicant respectfully disagrees with and traverses this rejection. However, Claim 1 has been amended to further clarify the subject matter being claimed.

More particularly, the Applicant respectfully submits that the Office Action's reasons for rejections are not in line with current US patent laws as defined by the Federal Circuit in *State Street Bank & Trust Co. v. Signature Financial*, 149 F.3d 1368 (Fed. Cir. 1998). In fact, the Applicant submits that the Office Action is applying an outdated test that has been replaced by the decision in *State Street Bank*.

In *State Street Bank*, the Federal Circuit stated that, for the most part, any invention that is one of a process, machine, manufacture, or composition of matter is statutory subject matter. The Court, however, noted three exceptions to this rule, namely laws of nature, natural phenomena, and abstract ideas. The Court touched on the latter exception of abstract ideas. *State Street Bank*, 149 F.3d, at 1373. In this regard, the Court stated that the test is that the

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invention must 1) fall into one of the listed categories: process, machine, manufacture, or composition of matter and 2) produce a "useful, concrete, and tangible result." In this regard, the claimed invention recited in Claim 1 is a method of analyzing and optimizing a workload schedule for a complex process with respect to available resources. The terms method and process are considered synonymous in patent law. Further, as already admitted in the Office Action, the claimed invention as recited in Claims 1-12 does produce a useful, concrete, and tangible result. This is all that is needed to qualify as statutory subject matter, as outlined by the Federal Circuit. See *State Street Bank*, 149 F.3d, at 1375.

The Applicant notes here that the Court in *State Street Bank* nowhere mentions determining whether the invention "applies, involves, uses, or advances the technological arts," as the Office Action is now requiring. That is, there is *no mention* in *State Street Bank* that the patentability of business inventions is conditioned on the use of the "technological arts." In fact, this phrase is nowhere present in the Opinion. Further, the Federal Circuit expressly held that business methods are patentable, overturning the previously-existing business method exception. "We take this opportunity to lay this ill-conceived exception to rest. Since its inception, the 'business method' exception has merely represented the application of some general, but no longer applicable legal principle." See *State Street Bank*, 149 F.3d, at 1375.

The Applicant also submits that the *State Street Bank* opinion provides a good example of why the present invention should be considered statutory subject matter. Specifically, in that case, the Federal Circuit considered a machine that determined a daily allocation of assets for two or more Spokes that are invested in the same Hub. The system determined the percentage share that each Spoke maintained in the Hub, while taking into consideration daily changes both in the value of the Hub's investment securities and in the concomitant amount of each Spoke's assets. The functions performed by the machine in *State Street Bank* could have clearly been done entirely by hand. However, the Federal Circuit found the machine to contain statutory subject matter. As such, the Office Action's finding that the present invention is not statutory subject matter because the steps listed can be performed entirely by hand is **completely contrary to the findings of the Federal Circuit to an analogous invention in the *State Street Bank* case.**

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Therefore, the Applicant submits that Claims 1-12 do recite statutory subject matter as outlined by the Federal Circuit in *State Street Bank*, and that the rejection of Claims 1-12 under 35 U.S.C. §101 have thus been overcome.

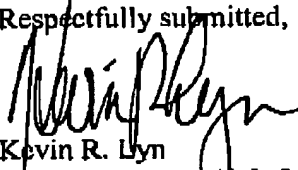
Conclusion

In summary, the 35 U.S.C. §§101 and 112 issues have been addressed and overcome by the Applicant in the pending claims and/or through the remarks presented herein. Accordingly, as stated in the Office Action under the heading "Allowable Subject Matter," the Applicant submits that the present invention, as defined by the pending claims, defines patentable and allowable subject matter. As such, Claims 1-36 are believed to be in condition for immediate allowance.

In conclusion, for the reasons set forth above, the Applicant submits that all claims now pending are in condition for immediate allowance. Accordingly, notice to such effect is respectfully requested at the Examiner's earliest opportunity.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

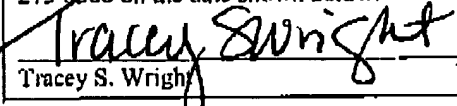

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